



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,796	02/06/2002	Koichi Kamon	44084-506	4491

20277 7590 04/27/2006

MCDERMOTT WILL & EMERY LLP  
600 13TH STREET, N.W.  
WASHINGTON, DC 20005-3096

EXAMINER

SHAH, AMEE A

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/066,796	<b>Applicant(s)</b> KAMON ET AL.	
	<b>Examiner</b> Amea A. Shah	<b>Art Unit</b> 3625	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8,10,11,13 and 15-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,11,13 and 15-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Claims 1-8, 10, 11, 13 and 15-22 are pending in this action.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 11, 2006, has been entered.

#### ***Response to Amendment***

The Amendment filed April 11, 2006, has been entered. In view of the Amendment, the objections regarding the Specification and claim 3 are withdrawn. Applicant's Amendment filed April 11, 2006, The Claims 1, 3, 7, 8, 10 and 13 have been amended, claims 9, 12 and 14 have been cancelled, and claims 20-22 have been added. Therefore, claims 1-8, 10, 11, 13 and 15-22 are pending in this action.

#### ***Response to Arguments***

Applicant's arguments filed April 11, 2006, have been fully considered but they are not persuasive. Applicant argues that the prior art Feld et al. does not disclose the added limitation of claims 1, 7, 8 and 10 that "the article for comparison is grouped and the comparison article group corresponding to the types of the displayed commercial products is selected." (Remarks/

Art Unit: 3625

Arguments, page 14). The Examiner respectfully disagrees. Feld et al. discloses the article for comparison is grouped corresponding to the types of clothing and selected items (Fig. 4 and page 3, ¶¶ 0036-0037).

Furthermore, this limitation is non-functional descriptive language further describing what the screen displays, similar to printed matter, that does not alter how the display functions (i.e. the descriptive material, the groupings, does not reconfigure the display). Thus, the non-functional descriptive material will not distinguish the claimed invention from the prior art Feld et al. in terms of patentability. *See In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowrey*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Similarly, the limitations in claims 1, 7, 8, 10 and newly added claim 22 of the images of the commercial product and the article for comparison displayed on the same scale, the images of the commercial product and the article for comparison not overlapping, and the observation image not deviating from the observation window are also non-functional descriptive material not altering how the display functions.

Please also note that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function, *see In re Danly* 263 F.2d 844, 847, 120 USPQ 582, 531 (CCPA 1959). A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1657 (Bd Pat. App. & Inter. 1987). Thus the structural limitations of claims 1, 7, 8, 10 and 22, including the reader, generator and display device are disclosed in Feld

et al. as described herein. Also, as described, the limitations of the claims do not distinguish the claimed apparatus from the prior art.

***Claim Rejections - 35 U.S.C. § 112***

The following is a quotation of the first paragraph of 35 U.S.C. §112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 and 22 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 1 and 22 contain the structural components of a reader and an observation image generator. Claims 1 and 22 do not indicate whether these components are program components executable by a computer, nor do they specify any other manner or means that enables the invented system. The Specification states that the reader and generator are components of a program such as an operating system and various applications that are executable by a computer (pages 10-12, ¶¶0050-0055). In order to comply with the enablement requirement of 35 U.S.C. §112, the Examiner recommends amending the claims to specify that the reader and generator are program components embodied on a medium and executable by a processor or computer. For purposes of this action only, the Examiner will interpret the structural components of a reader and generator to be program components embodied on a medium and executable by a computer. As claims 2-6

Art Unit: 3625

are dependencies of claim 1, they inherit its deficiencies, are rejected on the same bases, and are interpreted in the same manner for purposes of this action.

***Examiner Note***

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-8, 10, 11, 13 and 15-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Feld et al., U.S. Pat. App. Pub. No. 2001/0026272 A1 (hereinafter referred to as “Feld et al.”).**

Referring to claim 1. Feld et al. discloses an electronic catalogue system for displaying on one screen an image of a commercial product and an image of an article for comparison in order for a viewer of the one screen to acquire a visual recognition of the size of the commercial product as compared to the size of the article for comparison, comprising:

- reader for reading three-dimensional data of the commercial product and three-dimensional data of the article for comparison (page 3, ¶0035 and page 4, ¶¶0039-0040 – note the reader is the software, the commercial product is the clothing and the article for comparison is the model);
- observation image generator for generating an observation image in which the image of the commercial product and the image of the article for comparison are located at predetermined positions based on the read three-dimensional data of the commercial product and three-dimensional data of the article for comparison (page 4, ¶0040 and page 5, ¶0049 – note the image generator is the software); and
- displaying device for displaying the generated observation images, said displaying device including said one screen, wherein the image of the commercial product and the image of the article for comparison are displayed under a same scale on said one screen of the displaying device, and the article for comparison is grouped and the comparison article group corresponding to the types of the displayed commercial products is selected (Fig. 4 and page 3, ¶¶0036-0037, page 4, ¶0040 and page 5, ¶0049).

Referring to claim 2. Feld et al. also discloses the electronic catalogue system according to claim 1, further comprising:

- designator for designating a rotation axis and an angle of rotation (page 3, ¶0038 – note the designator is the mouse); and
- rotating device for rotating the observation image based on the designated rotation axis and the designated angle of rotation (page 3, ¶0038 – note the rotating device is the mouse working with the software)

Referring to claim 3. Feld et al. also discloses the electronic catalogue system according to claim 1, further comprising:

- designator for designating a rotation axis and an angle of rotation for each one of the commercial product and the article for comparison (page 3, ¶0038); and
- rotating device for rotating the image of the commercial product or the image of the article for comparison based on the designated rotation axis and the designated angle of rotation (Page 3, ¶0038).

Referring to claim 4. Feld et al. also discloses the electronic catalogue system according to claim 1, further comprising: dispose device for automatically selecting the article for comparison in accordance with a type and a size of the commercial product (page 6, ¶¶0056, 0061 and page 7, ¶¶0065-0067).



Referring to claim 5. Feld et al. also discloses the electronic catalogue system according to claim 1, further comprising:

- article for comparison storing device for storing three-dimensional data of a plurality of articles for comparison (page 5, ¶0047 – note the storing device is the model bank); and
- selector for selecting the three-dimensional data of one article for comparison from the article for comparison storing device, wherein the reader reads the three-dimensional data of the selected article for comparison (page 5, ¶0047 – note the selector is the mouse with the software).

Referring to claim 6. Feld et al. also discloses the electronic catalogue system according to claim 1, further comprising:

- product storing device for storing a product information regarding features of the commercial product (Fig. 3 and pages 3-4, ¶0039), said product information being associated with the three-dimensional data of the commercial product,
  - wherein the displaying device displays the observation image together with the product information which corresponds to the image of the commercial product which is included in the observation image (page 6, ¶0058 – note the product information is information relating to virtual wear articles).

Referring to claims 7 and 8. All of the limitations in apparatus claims 7 and 8 are closely parallel to the limitations of system claim 1, analyzed above and are rejected on the same bases.

Referring to claim 10. Feld et al. discloses a computer program product for a terminal apparatus used in an electronic catalogue system for displaying an image of a commercial product on a screen and an image of an article for comparison in order for a viewer of the screen to acquire a visual recognition of the size of the commercial product as compared to the size of the article for comparison, the computer program product comprising:

- a computer readable storage medium having a computer program stored thereon for causing the terminal apparatus to execute the operations of:
  - reading data for generating the image of the commercial product and data for generating the image of the article for comparison (page 3, ¶0035 and page 4, ¶¶0039-0040 –note the commercial product is the clothing and the article for comparison is the model),
  - generating an observation image in which the commercial product and the article for comparison are located at predetermined positions based on respective the read data, and changing a positional relationship between the commercial product and the article for comparison (page 4, ¶0040 and page 5, ¶0049); and
  - updating the observation image, wherein the image of the commercial product and the image of the article for comparison are displayed under a same scale on said screen (page 4, ¶0040 – note that updating the image is performed when displaying in real-time) and the article for comparison is grouped and the comparison article group corresponding to the types of the displayed commercial products is selected (Fig. 4 and page 3, ¶¶0036-0037 – note the groups are the windows).

Referring to claim 11. All of the limitations in apparatus claim 11 are closely parallel to the limitations of system claim 4, analyzed above and are rejected on the same bases.

Referring to claim 13. All of the limitations in apparatus claim 13 are closely parallel to the limitations of system claim 1, analyzed above and are rejected on the same bases.

Referring to claims 15-19. Feld et al. also discloses the electronic catalogue system, server and program products according to claims 1, 7, 8, 10 and 13

- wherein a display magnification for the article for comparison is calculated based on the size of the article for comparison, and both the size and a display magnification of the displayed commercial product (page 3, ¶0038, and page 7, ¶¶0065-0067), and
- the article for comparison is displayed at a predetermined position within the observation image based on the calculated display magnification (page 7, ¶¶0065-0067).

Referring to claim 20. Feld et al. further discloses the electronic catalogue system according to claim 1 wherein one article for comparison corresponding to the size of the commercial product is selected from the articles for comparison which are included in the selected comparison article group (Fig. 4 and page 3, ¶¶0035-0037 – note the article for comparisons are the model types) .

Referring to claim 21. All of the limitations in apparatus claim 21 are closely parallel to the limitations of apparatus claim 20, analyzed above and are rejected on the same bases.

Referring to claim 22. An electronic catalogue system for displaying on one screen a image of a commercial product and an image of an article for comparison in order for a viewer of the one screen to acquire a visual recognition of the size of the commercial product as compared to the size of the article for comparison, comprising:

- reader for reading three-dimensional data of the commercial product and three-dimensional data of the article for comparison (page 3, ¶0035 and page 4, ¶¶0039-0040 – note the reader is the software, the commercial product is the clothing and the article for comparison is the model);
- observation image generator for generating an observation image in which the image of the commercial product and the image of the article for comparison are located at predetermined positions based on the read three-dimensional data of the commercial product and three-dimensional data of the article for comparison (page 4, ¶0040 and page 5, ¶0049 – note the image generator is the software); and
- displaying device for displaying the generated observation image, said displaying device including said one screen, wherein the image of the commercial product and the image of the article for comparison are displayed under a same scale on said one screen of the displaying device, the image of the commercial product and the image of the article for comparison do not overlap with each other in an observation window, and the observation image does not deviate from the observation window (Fig. 4 and page 3, ¶¶0036-0038, page 4, ¶0040 and page 5, ¶0049).

***Conclusion***

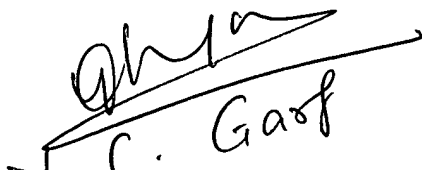
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogesh Garg can be reached on 571-272-6756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAS

April 25, 2006

  
J. C. Garg  
Primary Ex.